

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN P. LEAHY and COREY D. JONES

Appeal No. 1999-0944
Application No. 08/890,252

ON BRIEF

Before McCANDLISH, *Senior Administrative Patent Judge* and
STAAB and GONZALES, *Administrative Patent Judges*.

STAAB, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-4 in this broadening reissue application based on appellants' U.S. Patent 5,430,937, issued July 11, 1995. No other claims are currently pending.

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By way of background, this reissue application is related to appellants' copending reissue application SN 08/890,263. An appeal from the examiner's final rejection in the related '263 reissue application is decided concurrently herewith.

Appellants' invention pertains to an apparatus for fabricating a helicopter main rotor blade. Appealed claim 1 is representative of the appealed subject matter and reads as follows:¹

1. A sheath spreading/insertion apparatus for spreading a leading-edge sheath and for inserting the spread-apart leading-edge sheath in combination with a blade subassembly, comprising:

a [movable] stanchion;

a[n upper] first elongate carriage member mounted in movable combination with said [movable] stanchion;

a plurality of suction cups mounted in combination with said [upper] first elongate carriage member;

a [lower] second elongate carriage member mounted in movable combination with said [movable] stanchion;

a plurality of suction cups mounted in

¹ Reissue claim 1 is presented in the form prescribed by 37 CFR § 1.173, namely, with matter to be omitted by reissue enclosed in square brackets and with additions made by reissue underlined.

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combination with said [lower] second elongate carriage member;

means for imparting synchronized movement to said [upper] first and [lower] second elongate carriage members between a disengaged position wherein the leading-edge sheath [member] may be inserted between said pluralities of suction cups mounted in combination with said [upper] first and [lower] second elongate carriage members without contact therewith, an engaged position wherein said pluralities of suction cups abuttingly engage respective OML surfaces of the leading-edge sheath, and an operating position wherein the leading-edge sheath is spread apart for insertion [onto] in combination with the blade subassembly;

means for generating suction forces in said pluralities of suction cups in the engaged position to cause said suction cups to hold the respective OML surfaces of the leading-edge sheath such that subsequent synchronized movement of said [upper] first and [lower] second elongate carriage members to the operating position causes the leading-edge sheath to be spread apart; and

means for [moving said movable stanchion] imparting relative movement between the spread-apart leading-edge sheath and the blade subassembly to insert the spread-apart leading-edge sheath [onto] in combination with the blade subassembly.

No references are relied upon in the final rejection of claims 1-4.

Reissue claims 1-4 stands rejected under 35 U.S.C. § 112,

first paragraph, as being based upon a patent disclosure that fails to provide descriptive support for the invention as now claimed.^{2,3}

The examiner's rationale for the rejection is found on pages 2-3 of the final rejection and reads as follows:⁴

The change to first and second in place of upper and lower . . . [is] considered new matter [T]he terms first and second are much broader than the terms upper and lower. First and second can mean forward and rearward or left and right for example, which are clearly different than upper and lower and therefore not disclosed in the specification as originally filed. . . . No where [sic] in the original specification were the parts ever disclosed as being anything other than upper and lower. . . .

The examiner is correct that the claim language "first"

² In the final rejection, the examiner also objected to the specification and drawing as containing new matter; however, this objection has not been expressly carried forward in the examiner's answer. Had the examiner maintained the objection, we would have been obligated to consider the merits thereof. See M.P.E.P. § 2163.06 (II) REVIEW OF NEW MATTER OBJECTIONS AND/OR REJECTIONS.

³ Based on the designation of elements 66U and 66L as upper and lower suction cups, and the depiction of the apparatus in Figure 3 as being supported on a ground surface, it is apparent that Figure 3 is a partial elevation of the apparatus. Accordingly, the description of Figure 3 in the BRIEF DESCRIPTION OF THE DRAWINGS section of the specification should be amended to reflect that Figure 3 is a partial elevation view of Figure 2 rather than a partial plan view thereof.

⁴ Upon consideration of appellants' arguments in the main brief, the standing 35 U.S.C. § 112, first paragraph, rejection is no longer based on changing "onto" in patent claims 1-3 to "in combination with" in reissue claims 1-3. See page 3 of the examiner's answer.

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and "second" does not expressly appear in the original patent in describing the carriage members 60U, 60L. However, the claimed subject matter need not be described *in haec verba* in the specification in order for the specification to satisfy the "written description" requirement of § 112, first paragraph, *In re Smith*, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1973), and all new language added by amendment is not *ispo facto* new matter. *In re Wright*, 343 F.2d 761, 767, 145 USPQ 182, 188 (CCPA 1965).

Where, as here, the specification contains a written description of the claimed invention, but not *in ipsis verbis*, the examiner, in making a rejection under the "written description" requirement of § 112, first paragraph, must meet the requisite burden of proof by providing reasons why one of ordinary skill in the art would not consider the description sufficient. Once the examiner has carried the burden of making out a *prima facie* case of unpatentability the burden of coming forward with evidence or argument shifts to the applicant to show that the invention as claimed is adequately described to one skilled in the art. *In re Alton*, 76 F.3d

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1168, 1175, 37 USPQ2d 1578, 1583-84 (Fed. Cir. 1996). If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the

specification, then the adequate written description requirement is met. *Id.*, 76 F.3d at 1175, 37 USPQ2d at 1584.

In this case we do not consider the reasons given by the examiner sufficient to make out a *prima facie* case of noncompliance with the "written description" requirement. In this regard, while it is true that the terms "first" and "second" in reissue claims 1, 3 and 4 are broader than the terms "upper" and "lower" used in patent claims 1, 3 and 4, this circumstance alone is not sufficient to warrant a conclusion that the reissue claims lack descriptive support.

See In re Rasmussen, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981)(an applicant is not limited to claiming only the specific embodiment described in the specification, but may instead claim his invention as broad as the prior art *and his disclosure* will allow). In the present instance, there is nothing in the patent disclosure when read in its entirety that would lead one of ordinary skill in the art to conclude that the inventive apparatus necessarily depends on positioning the carriage members such that they are oriented in upper and lower positions. In fact, certain passages in the patent specification that describe the invention in more general

terms suggest just the opposite, i.e., that orienting the carriage members 60U, 60L in upper and lower positions is not a necessary requirement.⁵ Accordingly, we are in agreement

⁵ See, for example, page 10, line 25, through page 11, line 5, of the specification, which reads as follows (with italics added for emphasis):

Pluralities of suction cups 66U, 66L are *disposed in aligned combination, i.e. rows, with the respective carriage members 60U,*

(continued...)

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with appellants that one of ordinary skill in the art would appreciate that the inventive apparatus disclosed in the patent utilizes first and second carriage members.

In light of the foregoing, we will not sustain the standing rejection of reissue claims 1-4 under 35 U.S.C. § 112, first paragraph.

Remand to the Examiner

Pursuant to 37 CFR § 1.196(e), this application is remanded to the examiner to consider the following issues:

(1) Do reissue claims 1-4, which are directed to an apparatus for *inserting* the spread-apart leading-edge sheath *in combination with* a blade subassembly, particularly point out and distinctly claim the subject matter which appellants regard as their invention, as required by the second paragraph of 35 U.S.C. § 112?⁶

⁵(...continued)

60L along the spanwise length thereof The suction cups 66U, 66L are operative to engage and hold the respective OML surfaces of the leading edge sheath 120 with the vacuum source 68 actuated. Subsequent synchronized movement of the respective carriage members 60U, 60L away from one another to the operating position causes spreading of the sheath 120 to facilitate insertion thereof in combination with the blade subassembly 132.

⁶ It is fundamental that the description requirement found in the first paragraph of 35 U.S.C. § 112 and the definiteness requirement found in the second paragraph of 35 U.S.C. § 112 are separate and distinct. Accordingly, just because claim language may have been properly "described" in the disclosure as originally filed, it does not necessarily follow that that claim

(continued...)

The purpose of the requirement stated in the second paragraph of 35 U.S.C. § 112 is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

In the present case, appellants seek to change by reissue the wording of apparatus claims 1-4 at several places from an apparatus for *inserting* the leading-edge sheath *onto* the blade subassembly to an apparatus for *inserting* the leading-edge sheath *in combination with* the blade subassembly.⁷ Because the commonly accepted dictionary definitions of the words "inserting" and

⁶(...continued)
language also passes muster under the second paragraph of 35 U.S.C. § 112.

⁷ The specific claim language is located at claim 1, lines 19-20; claim 1, lines 26-28; claim 2, lines 2-3; and claim 3, lines 16-17.

"onto" as appears in original patent claims 1-3 and throughout the specification are almost mutually exclusive⁸, it appears that appellants are using the word "inserting" in a way that does not comport with its plain meaning. Precisely what that meaning may be, however, is not apparent from the disclosure. Moreover, changing the wording of claims 1-3 from *inserting* the leading-edge sheath *onto* the blade subassembly to *inserting* the leading-edge sheath *in combination with* the blade subassembly only serves to further obscure what appellants may intend the words "insertion" (claim 1, line 19; claim 3, line 16), "insert" (claim 1, line 27), and "inserted" (claim 2, line 2) to mean. Accordingly, the examiner should (1) consider whether one of ordinary skill in the art can readily and accurately determine the meaning and scope of the claimed apparatus for *inserting* the spread-apart leading-edge sheath *in combination with* the blade subassembly , and (2) if not, enter a new rejection of reissue

⁸For example, the verb "insert" may mean "[t]o put or set into, between, or among," whereas the preposition "onto" may mean "[o]n top of: upon." *Webster's II New Riverside University Dictionary*, copyright © 1984 by Houghton Mifflin Company.

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claims 1-4 under the second paragraph of 35 U.S.C. § 112.

(2) Does the addition to the specification at page 11, line 33 through page 12, line 4 violate the prohibition against the introduction of new matter into an application for reissue found in the first paragraph of 35 U.S.C. § 251?

At page 1, line 33, of the specification, appellants have added to the disclosure a reference to "alternative embodiments" that include, *inter alia*, stanchions "of a type known in the art" in place of the stanchion 52. In our opinion, there is no support in the original patent disclosure for such "alternative embodiments." In addition, we note that appellants, of their own volition and without explanation, canceled a similar addition to the specification of related copending reissue application SN 08/890,263, thus raising the question of whether appellants themselves consider this addition to have proper support in the disclosure of the original patent. Accordingly, the examiner should (1) carefully consider whether the addition in question complies with the reissue statute, and (2) if not, enter an objection to the specification under 35 U.S.C. § 251.

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To summarize, the decision of the examiner finally
rejecting claims 1-4 under 35 U.S.C. § 112, first paragraph,
is reversed.

The application is remanded to the examiner to consider
the issues discussed above and to take appropriate action in
light thereof.

REVERSED and REMANDED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS AND
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